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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,997	11/20/2000	Robert C. Ross, Jr.	36956-168147	6701
26694	7590	11/17/2005	EXAMINER	
VENABLE LLP			NEURAUTER, GEORGE C	
P.O. BOX 34385			ART UNIT	
WASHINGTON, DC 20045-9998			PAPER NUMBER	

2143

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/714,997	Applicant(s) ROSS, JR., ROBERT C.	
	Examiner George C. Neurauter, Jr.	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-20 are currently presented and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 October 2005 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 9-20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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1. Claims 9-20 are rejected under 35 U.S.C. 102(b) as being anticipated by "Using Microsoft Outlook 98" ("Outlook").

Regarding claim 9, "Outlook" discloses an electronic mail system comprising:

a user-assignable personal file folder ("mailbox") adapted to store user selected previously received incoming messages ("Inbox"; page 200, Figure 12.2) and all outgoing messages ("Sent Items"; page 200, Figure 12.2) (see also page 202, specifically "Instead of saving all your incoming messages in your Inbox folder, and all your outgoing messages in your Sent Items folder..."); and

at least one sent mail sub-folder in said user-assignable personal file folder, wherein a copy of said each of said outgoing messages is automatically stored in said sent mail sub-folder, and wherein said sent mail sub-folder is named by one of said outgoing message's recipient's e-mail address or said outgoing message's recipient's user name. (page 202, "Creating Folders and Subfolders", specifically "[Y]ou can create subfolders under top-level folders" and "Instead of saving all your incoming messages in your Inbox folder, and all your outgoing messages in your Sent Items folder, you might like to create a folder for each important contact and save incoming and outgoing messages together in that folder")

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Regarding claim 10, "Outlook" discloses the system according to claim 9, wherein emails sent from at least one of a sender and/or a recipient are automatically stored in one or more of said user-assignable personal file folders. (page 202, "Creating Folders and Subfolders", specifically "Instead of saving all your incoming messages in your Inbox folder, and all your outgoing messages in your Sent Items folder, you might like to create a folder for each important contact and save incoming and outgoing messages together in that folder"; page 340, "What is a Rule?", specifically "A rule is a set of conditions and actions for processing and organizing your messages. The conditions are used to select, or identify, messages for special processing, and the actions determine what kind of processing you want to have performed automatically...Put all incoming and outgoing messages that have the word "Training" in the subject, into my "Training Messages" folder...Move messages newly received messages from a specified sender or list to a destination folder)

Regarding claim 11, "Outlook" discloses the system according to claim 10, wherein said user assignable file folders are automatically tagged by one of the email address or the username of a sender of a received email and a receiver of a sent email. (page 202, "Creating Folders and Subfolders",

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specifically "Instead of saving all your incoming messages in your Inbox folder, and all your outgoing messages in your Sent Items folder, you might like to create a folder for each important contact and save incoming and outgoing messages together in that folder"; page 340, "What is a Rule?", specifically "A rule is a set of conditions and actions for processing and organizing your messages. The conditions are used to select, or identify, messages for special processing, and the actions determine what kind of processing you want to have performed automatically...Move messages newly received messages from a specified sender or list to a destination folder")

Regarding claim 12, "Outlook" discloses the system according to claim 9, wherein each of said user-assignable personal file folders comprises a dynamic, active read receipt report stored on a system of a sender of an email (page 538, specifically "Tell me when all messages have been read").

Regarding claim 13, "Outlook" discloses the system according to claim 12, wherein said dynamic, active read receipt report comprises a single file indicating read receipt status indicating which of a plurality of recipients of an email have and have not accessed said email (page 538, specifically "Tell me when all messages have been read").

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Regarding claim 14, "Outlook" discloses the system according to claim 13, further comprising tracking a date and time of access by one of said plurality of recipients (page 538, specifically "Tell me when all messages have been read")

Regarding claim 15, "Outlook" discloses the system according to claim 9, wherein the system is adapted to automatically create at least one new sent mail sub-folder when a sent mail sub-folder does not exist for said outgoing message's one or more recipients. (page 202, "Creating Folders and Subfolders", specifically "Instead of saving all your incoming messages in your Inbox folder, and all your outgoing messages in your Sent Items folder, you might like to create a folder for each important contact and save incoming and outgoing messages together in that folder"; page 340, "What is a Rule?", specifically "A rule is a set of conditions and actions for processing and organizing your messages. The conditions are used to select, or identify, messages for special processing, and the actions determine what kind of processing you want to have performed automatically"; page 345, specifically "Figure 21.7 shows the Rules Wizard dialog box for selecting the folder where we want to move Mary's messages...If you haven't created the folder yet, click the New button to create and name the new folder")

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Regarding claim 16, "Outlook" discloses the system according to claim 9, further comprising at least one received mail sub-folder in said user-assignable personal file folder, wherein each of said incoming messages is automatically stored in said received mail sub-folder, and wherein said received mail sub-folder is named by one of said incoming message's sender's e-mail address or said incoming message's sender's user name. (page 202, "Creating Folders and Subfolders", specifically "[Y]ou can create subfolders under top-level folders" and "Instead of saving all your incoming messages in your Inbox folder, and all your outgoing messages in your Sent Items folder, you might like to create a folder for each important contact and save incoming and outgoing messages together in that folder")

Regarding claim 17, "Outlook" discloses the system according to claim 16, wherein the system is adapted to automatically create a new received mail sub-folder when a received mail sub-folder does not exist for said incoming message's sender. (page 202, "Creating Folders and Subfolders", specifically "Instead of saving all your incoming messages in your Inbox folder, and all your outgoing messages in your Sent Items folder, you might like to create a folder for each important contact and save incoming and outgoing messages

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together in that folder"; page 340, "What is a Rule?", specifically "A rule is a set of conditions and actions for processing and organizing your messages. The conditions are used to select, or identify, messages for special processing, and the actions determine what kind of processing you want to have performed automatically"; page 345, specifically "Figure 21.7 shows the Rules Wizard dialog box for selecting the folder where we want to move Mary's messages...If you haven't created the folder yet, click the New button to create and name the new folder")

Claims 18-20 are also rejected since claims 18-20 recite a machine-readable medium that contains substantially the same limitations as recited in claims 9, 11, and 15 in combination and are rejected under the citations of "Outlook" shown above.

Claims 9-20 are rejected as being anticipated by Examiner's Official Notice.

Examiner takes Official Notice (see MPEP § 2144.03) that rules or filter-based processing of a user's mailbox wherein folders are created and incoming and outgoing messages are stored within the folders based on a criterion in the email received or sent and sending read receipts to the sender when a user opens an email messages in a electronic mail system was well known in the art at the time the invention was made. The

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Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Allowable Subject Matter

Claims 1-8 are allowed for the reasons indicated previously.

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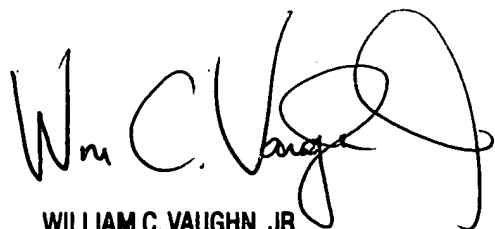
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gcn


WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER